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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/589,264	08/14/2006	Roland Wursche	291789US0PCT	6049
22850	7590	12/11/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER FREEMAN, JOHN D	
			ART UNIT 1794	PAPER NUMBER
			NOTIFICATION DATE 12/11/2008	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/589,264	<b>Applicant(s)</b> WURSCHE ET AL.	
	<b>Examiner</b> John Freeman	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 1-5 and 8-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6 and 7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/06, 12/06, 9/07, 3/08, 11/08</u> .                          | 6) <input type="checkbox"/> Other: _____                          |

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## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group I, claims 6 and 7, as well as formula (I) for monomer unit (a) and formula (VI) for monomer unit (b) in the reply filed on 2 September 2008 is acknowledged. The traversal is on the ground(s) that the claims of Groups I-V "are considered to have unity of invention" under 37 C.F.R. 1.475(b), and that a "search of all the claims would not impose a serious burden on the Office." This is not found persuasive because there is no linking special technical feature in the claims. According to PCT Rule 13.2, in a national stage filing under the requirement for unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding technical features, wherein said special technical features refer to those features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. The technical feature shared among the claims is the adhesion promoter in claim 1. In the original requirement for restriction, the examiner lent weight to the International Searching Authority via the International Search Report, which pointed to US 4,301,216 as a document that discloses the presently claimed adhesion promoter. Therefore, the technical feature of the claims does not define a contribution over the prior art. Furthermore, the examiner lays out rejections below that recite all the features of the presently claimed composite.

2. Applicant also argues that unity of invention has to be considered only in relation to the independent claim, and that it "does not matter if a dependent claim itself contains a further invention." However, although claim 6 contains a reference to another claim, it is not considered a dependent claim as defined in PCT Rule 6.4 since it refers to a claim of a different category (see MPEP 1850 II).

The requirement is still deemed proper and is therefore made FINAL.

3. Claims 1-5, and 8-13 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 2 September 2008.

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***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 6-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Oenbrink et al. (US 5,637,408).

6. Oenbrink et al. (hereafter Oenbrink) disclose a multilayer composite comprising (col 1 ln 55-63):

- (I) a layer of polyamide,
- (II) a layer of polyalkyl methacrylate, bonded via
- (III) a coupling layer.

The coupling layer comprises (i) up to 96% by weight of acrylate-derived units (col 4 ln 35-45), and (iv) 0.2-25% by weight of anhydride-based units (col 4 ln 66-col 5 ln 10).

7. The examiner notes present claim 7 limits the identity of an additional layer or layers, however, the claim as written does not require said layer or layers. The examiner also notes polyalkyl methacrylate layers are inherently functional: Oenbrink uses them for mechanical properties and UV resistance (col 1 ln 13-25).

8. Claims 6-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Ries et al. (US 6,680,093).

9. Ries et al. (hereafter Ries) disclose a multilayer composite comprising (claim 1):

- (I) a layer of polyamide,
- (II) a layer comprising polyester or fluoropolymer, bonded via
- (III) an adhesive layer.

The adhesive layer comprises an alkyl acrylate polymer comprising (i) up to 100% of acrylate-derived units, and (iv) 0-20% by weight of anhydride-based units (claims 4-6). The composite can be in a sheet form (col 7 ln 36-41).

10. The examiner notes present claim 7 limits the identity of an additional layer or layers, however, the claim as written does not require said layer or layers. The examiner also notes polyester or fluoropolymer layers are inherently functional: they inherently provide water and/or chemical resistance.

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***Claim Rejections - 35 USC § 112***

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 6-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

13. Claim 6 recites the multilayer film comprises at least one layer of "the adhesion promoter as claimed in claim 1." Since claim 1 is directed to a method of using an adhesion promoter and not the adhesion promoter itself, it is unclear exactly which limitations of claim 1 are imported into claim 6.

14. Claim 1, upon which claims 6 and 7 depend, recites "vinyl compounds selected from acrylic acid derivatives, methacrylic acid derivatives, and vinylaromatic derivatives". The term "derivatives" renders the claims indefinite, as it is unclear what is meant and encompassed by this term. For example, it is unclear whether acrylic acid is considered to fall under the scope of "acrylic acid derivatives," even though it is unmodified. For examination purposes, the examiner interprets the claim to include unmodified forms of the monomers listed.

15. Claim 7 recites "one or more other layers," but does not positively recite the presence of the layers in the multilayer film. It is unclear whether the layers are required by the claim.

16. Claim 7 recites layers including a "color layer" and a "functional layer." It is unclear what is meant or encompassed by these terms.

***Conclusion***

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The examiner notes Grant '216 is relevant to the claims, but is not applicable to the *elected species*. Lorek '025, Lorek '415, and Montanari '035 disclose adhesives based on units of polyalkyl acrylate and anhydrides.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Freeman whose telephone number is (571)270-3469. The examiner can normally be reached on Monday-Friday 7:30-5:00PM EST (First Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on (571)272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

John Freeman  
Examiner  
Art Unit 1794

/John Freeman/  
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/Callie E. Shosho/  
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